

## **REMARKS**

### **Pending Claims after November 11, 2004 Election**

In the office action mailed February 9, 2005, the Examiner stated that claims 3, 4, 7, 12 and 20-22 are withdrawn from consideration. Applicant disagrees.

In a reply dated November 17, 2004, Applicant elected Group I claims (claims 1-19) drawn to a prostheses and the specific species including FIG. 2B of category A and frictional engagement from category B. After the election, the elected apparatus claims that are pending are claims 1, 2, 4-6, 8, 9, 11-19. Of these elected claims, claims 1, 2, 13 and 16-19 are generic to all elected apparatus species. Applicant contends that the only withdrawn claims are claims 3, 7 and 10 which are drawn to an unelected apparatus species and claims 20-22 drawn to an unelected group of method claims.

According to MPEP 809.02(c) Action Following Election, "an examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species." After Applicant's election, claims 4 and 10 are pending and drawn to an elected apparatus species. The Examiner's assertion that the withdrawn claims include 3, 4, 7, 12 and 20-22 is incorrect inasmuch as it improperly withdraws from consideration claims 4 and 12 that are drawn to the elected apparatus species.

In addition, the Office Action does not address all claims drawn to the elected apparatus species as set forth by MPEP 809.02 (c). Applicant's discussion below covers these claims.

As such, the withdrawn claims are 3, 7, 10, and 20-22. Applicant has annotated the claim listing beginning on Page 2 in accordance with the November 17, 2004 election. Applicant requests the Examiner correct the status of the pending and withdrawn claims in the current Office Action in view of Applicant's election dated November 11, 2004.

Reconsideration is respectfully requested in view of the following remarks.

### **Claims Rejections – 35 USC § 102**

Claims 1, 2, 8, 9, 11, 13-17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,314,486 to Zang et al ("Zang '486").

Claim 1 has been amended to more particularly point out and distinctly claim that which the Applicant regards as his invention. Amended claim 1 recites, in relevant part, “a prosthesis to replace all or a portion of a natural facet joint on a vertebral body, comprising; a fastening element adapted to be installed within the vertebral body at or near a pedicle and without support by a lamina;... .”

As the Examiner correctly notes, Zang ‘486 is directed towards a joint prosthetic replacement device for a metatarso-phalangeal joint (See, e.g., Zang ‘486 Abstract). Zang ‘486 does not describe how any of the components of his metatarsal – phalangeal devices are “adapted to be installed within the vertebral body at or near a pedicle and without support by a lamina” as required by claim 1. Moreover, Zang ‘486 does not suggest that his metatarsal–phalangeal devices are suited for anything but prosthesis of the phalangeal joints.

Newly amended claim 1 is directed towards a prosthesis to replace all or a portion of a natural facet joint on a vertebral body. The loading characteristics, articulation and purpose of the spinal facet joint are quite different from the loading characteristics, articulation and purpose of the phalangeal joints. Zang ‘486 is silent as to any alleged suitability of his devices for any other joint much less a specific reference of suitability for use in the spinal facet. As such, there is no suggestion that Zang’s phalangeal prosthesis are even suitable for installation in a vertebral body much less “adapted to be installed within the vertebral body at or near a pedicle and without support by a lamina” as required by newly amended claim 1. Thus, Zang ‘486 cannot anticipate newly amended claim 1 because Zang ‘486 neither teaches nor suggests the limitation of “a fastening element adapted to be installed within the vertebral body at or near a pedicle and without support by a lamina” as required by newly amended claim 1.

In view of the above, Applicant requests that the rejection of claim 1 under 35 USC 102 as anticipated by Zang ‘486 be withdrawn. Because newly amended independent claim 1 is allowable over Zang ‘486, the claims depending from the allowable independent claim are also allowable. Applicant requests that the rejection of dependent claims 2, 8, 9, 11, 13-17 and 19 also be withdrawn.

**Claims Rejections – 35 USC § 103**

**Claims 5, 6 and 18**

Claims 5, 6, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zang, et al. (US 5,314,486) as applied to claim 1 above, and further in view of US 5,609,641 to Johnson et al. (“Johnson ‘641”). Zang ‘486 and its shortcomings are discussed above with regard to newly amended independent claim 1. Johnson ‘641 is directed towards tibial prosthesis. Assuming arguendo that there is a motivation in one of these references to combine Zang’s phalangeal joint prosthesis with Johnson’s tibial prosthesis, such a combination fails to render obvious newly amended claim 1. Neither Zang ‘486 nor Johnson ‘641 make reference to, suggest or describe how either of their prosthesis alone or in any combination provide “a fastening element adapted to be installed within the vertebral body at or near a pedicle and without support by a lamina” as claimed. As such, claim 1 is not rendered obvious by Zang ‘486 or Johnson ‘641 either alone or in any combination. Amended claim 1 is unobvious and allowable in view of Zang ‘486 and/or Johnson ‘641. Because claims 5, 6, and 18 all depend from an allowable independent claim, claims 5, 6 and 18 are allowable as well. Applicant requests that the rejection of dependent claims 5, 6, and 18 under 35 USC 103 in view of Zang ‘486 and/or Johnson ‘641 be withdrawn.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zang, et al. (US 5,314,486) as applied to claim 1 above, and further in view of US 4,955,916 to Carignan et al. (“Carignan ‘916”).

Zang ‘486 and its shortcomings are discussed above with regard to newly amended independent claim 1. Carignan ‘916 is directed towards a thumb joint prosthesis. Assuming arguendo that there is a motivation in one of these references to combine Zang’s phalangeal joint prosthesis with Carignan’s thumb joint prosthesis, such a combination fails to render obvious newly amended claim 1. Neither Zang ‘486 nor Carignan ‘916 make reference to, suggest or describe how either of their prosthesis alone or in any combination provide “a fastening element adapted to be installed within the vertebral body at or near a pedicle and without support by a lamina” as claimed. As such, claim 1 is not rendered obvious by Zang ‘486 or Carignan ‘916 either alone or in any combination. Newly amended claim 1 is unobvious and allowable in view of Zang ‘486 and/or Carignan ‘916. Because claim 10 depends from an allowable independent claim, claim 10 is

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allowable as well. Applicant requests that the rejection of dependent claim 10 under 35 USC 103 in view of Zang '486 and/or Carignan '916 be withdrawn.

### CONCLUSION

The pending claims have been rejected as anticipated by or obvious in view of Zang '486. In light of the remarks set forth above, Applicants believe that all rejections have been overcome and that all pending claims are in condition for allowance which is hereby requested.

Should the Examiner have any questions regarding this application, the Examiner is encouraged to telephone the undersigned.

Respectfully submitted,

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